



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/953,719	10/17/1997	DAISUKE YOSHIDA	35.C12338	4164

5514 7590 05/01/2006

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

PIZIALI, JEFFREY J

ART UNIT	PAPER NUMBER
----------	--------------

2629

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Notice of Abandonment

Application No.

08/953,719

Examiner

Jeff Piziali

Applicant(s)

YOSHIDA ET AL.

Art Unit

2629


-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 22 August 2005.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☒ A reply was received on 9/22/05 and 1/25/06 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

See Continuation Sheet

  
BIPIN SHALWALA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

  
J.P.  
4 March 2006

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Item 7 - Other reasons for holding abandonment: The reply filed on 25 January 2006 is not fully responsive to the prior Office Action (mailed 22 August 2005), because the submitted "Preliminary Amendment, Claim to Priority, and Information Disclosure Statement" is merely seeking for a third time to elect a previously identified non-elected (and withdrawn) invention.

As explained in the Office Action mailed 22 August 2005, the Amendment filed 12 May 2003 canceled all claims drawn to the originally presented invention. As explained in the Office Action mailed 29 December 2005, all six independent claims 1, 18, 49, and 52-54 (as newly altered/added by the Amendment filed 12 May 2003) were drawn to a non-elected invention, and continued attempts at electing the non-elected invention would continue to be viewed as an incomplete and improper (i.e. non bona fide) response.

The reply filed on 25 January 2006 appears designed for submission into divisional application serial number 11/338,531 (filed 23 January 2006), and to have been mistakenly submitted into the instant application. For instance, the reply filed on 25 January 2006 is labeled as a "Preliminary Amendment" of a "division application" (see page 1), and includes a foreign priority claim (see page 21) that was already well established in the instant application. Additionally, most of the references listed on the Information Disclosure Statement (PTO 1449) filed 25 January 2006 have already been considered in the instant application, and page 2 of the IDS indicates being a part of a "Div. Of 08/935,719."

Even if arguably the reply filed on 25 January 2006 were indeed intended for inclusion in the instant application, the amendments to the claims are non-compliant for at least the reason of the listing of claims not including a correct copy of all pending claims. The reply filed on 25 January 2006 appears to be amending the originally submitted copy of claims (and ignoring any and all amendments made during prosecution of the instant application since then).

Furthermore, the independent claims 1, 18, 39, 42-44 (as newly altered/added by the Amendment filed 25 January 2006) again include the non-elected subject matter of "a horizontal scanning circuit for controlling a sampling of digital video data in the different sequencing order," or (the functional equivalent of) "a horizontal scanning circuit for controlling a sampling of the order-changed digital video data." As explained in the Office Action mailed 22 August 2005, such subject matter is drawn to a non-elected, independent, and distinct invention than was originally claimed, searched, and examined.

The applicants were warned in the Office Action mailed 29 December 2005, that any continued attempts at electing the non-elected invention would continue to be viewed as an incomplete and improper (i.e. non bona fide) response. As such, holding the amendment filed on 25 January 2006 as non-responsive is deemed necessary, proper, and thereby maintained at this time.

Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

With it being more than six months since mailing the Office Action (on 22 August 2005), and without receiving a proper reply, the examiner telephoned Mr. John A. Krause (Registration No. 24,613) on 3 April 2006 to confirm abandonment.

The Information Disclosure Statement (PTO 1449) submitted 25 January 2006 has been signed and attached.

The applicants are hereby notified that the examiner's art unit has recently changed from Art Unit 2673 to Art Unit 2629, please direct all future correspondence accordingly. Thank you.

-OB  
4/4/06